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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/665,794 | 09/22/2003 | Keiko Shiraishi | 115031 | 7273 |

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| EXAMINER | |
|---|---|
| BLACKWELL, JAMES H | |
| **ART UNIT** | **PAPER NUMBER** |
| 2176 | |

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/665,794 | SHIRAISHI ET AL. | |
| | Examiner | Art Unit | |
| | James H. Blackwell | 2176 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This Office Action is in response to an original application filed 09/22/2003 with a priority date of **09/20/2002.**

2. Claims 1-13 are currently pending. Applicant amended claim 11 by a pre-amendment filed 09/22/2003.

3. Claims 1-4* and 9-11 are independent claims (* see 112 2nd rejection below)

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding Claim 4: It is unclear as to whether this claim was intended to be an independent or dependent claim. The majority of the substance and structure of the limitations found in this claim is consistent with that of an independent claim. However, in Claim 4, there exist a wording of limitations that is more consistent with that of a dependent claim. For example, Claim 4 recites, "...the linking information making device according to Claim 1 which requires the service list transmitted from the search device". This wording suggests that Claim 4 is to be interpreted as a dependent claim.

In addition, it is unclear whether or not all the limitations of Claim 1 are to be incorporated into Claim 4 by this limitation.

Revision will be required in order to properly interpret these claims.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salgado et al. (hereinafter Salgado, U.S. Patent No. 5,872,569 filed 10/30/1995, issued 02/16/1999).

**In regard to independent Claim 1 (and similarly independent Claims 2-3, and 9),**

Salgado teaches an apparatus and method for programming and controlling a job in a document processing system (Col. 13, lines 43-67; Col. 14, lines 1-21, 35-48, 58-67; Col. 16, lines 15-31, 62-67; Col. 17, lines 9-49; Col. 19, lines 12-33; and Figs. 6-13). Various office devices are connected through a local area network, their sets of device functionalities/attributes my be downloaded into the application server through networks, and it is possible to regularly query all the devices within the network so as to determine if a new device has been added or if the application of any device has been updated (compare with limitations *a service list acquisition unit, which acquires a service list expressing respective services, which execute predetermined processing of document data* and *an interface information acquisition unit which individually acquires pieces of interface information from service processing devices respectively providing the services expressed in the service list which has been acquired by the service list*

*acquisition unit*). Although Salgado does not explicitly mention a service list, it would have been obvious to one of ordinary skill in the art at the time of invention to conclude that such a list would have at least been constructible from the taught capability/attribute sets downloaded to the application server for each device (Col. 14, lines 35-48). The benefit would have been to have a current listing of devices available to the user.

Salgado also teaches that in that in order to build a metaphorical template of a job object, metaphors (icons) representing various component devices are coupled by way of arrow connectors (links), the connector (link) being associated with job requirements (Col. 17, lines 9-49) (compare to the limitation *a linking information making unit which makes linking information to link services provided by the respective service processing devices, based on the interface information which has been acquired by the interface information acquisition unit*).

**In regard to independent Claim 4,** Claim 4 reflects the linking information making device, as claimed in Claim 1 and is rejected along the same rationale.

In addition, Salgado also teaches *a plurality of service processing devices which provide services for executing predetermined processing of document data and transmit pieces of service information at any time* (see Figs 6-13 icons represent hardware/software devices (services) available to the user to construct templates for jobs).

Salgado also teaches *a search device provided with: a service information storage unit for storing the pieces of service information which have been transmitted at any time from currently-available service processing devices* in that for each component

coupled with the network (134), a profile representing the coupled component is developed (step 150) for storage in the database (126) (steps 152). For purposes of the present description, the capability of a device refers to each feature available for the device, whether that feature is enabled or not. An attribute of a device, on the other hand, refers to an enabled feature currently available to a user. As will be understood, there are various ways in which the profiles can be constructed for storage in the database (Col. 14, lines 35-49; database stores information on each device).

Salgado also teaches that templates can be searched for in the database, which contains information on each of the devices (compare with limitation, *a search unit for searching services corresponding to services, for which search has been requested, using the pieces of service information which have been stored in the service information storage unit*). The results are then transmitted to the user for incorporation into either a developing template, or to use standalone (compare with the limitation,

*a transmission unit which transmits a service list based on the search results of the search unit*) (Col. 14, lines 35-49; database transmits search results to user).

**In regard to dependent Claim 5,** Salgado teaches that *the transmission unit of the search device transmits the service list expressing services which are services provided by currently-available service processing devices and correspond to services for which search has been requested, to the linking information making device* (Col. 14, lines 35-49; user connects services icons on a desktop).

**In regard to dependent Claim 6 (and similarly dependent Claim 12),** Salgado teaches that *the service processing devices transmit pieces of input information and*

*pieces of output information on services, service names, and service information location as service information* (see Figs. 12, 16; Fig. 16 lists examples of attributes).

**In regard to dependent Claim 7,** Claim 7 contains subject matter similar to that found in Claim 6, and is rejected along similar lines of reasoning.

**In regard to dependent Claim 8 (and similarly dependent Claim 13),** Salgado teaches *a service linking processing device, which executes linking processing of services provided by the respective service processing devices, based on the linking information made by the linking information making device* (Col. 17, lines 15-22; links perform executions of the linked metaphors (icons) representing services).

**In regard to independent Claim 10,** Salgado teaches *a memory storing pieces of service information, which are transmitted at any time from currently available service processing devices* (Col. 7, lines 61-67; Col. 8, lines 1-3; memory stores information about devices).

Salgado also teaches *a controller which searches services corresponding to services for which search has been requested, using pieces of service information stored in the memory, and makes a service list expressing services, for which search has been requested, and pieces of port information, based on the search result* (Col. 19, lines 12-33).

Salgado does not explicitly teach a controller. However, it would have been obvious to one of ordinary skill in the art at the time of invention to conclude that a controller would have been involved in order to mediate the search between the user and the database, providing the benefit of a simple and efficient way to shorten the

process of template development by picking and choosing from templates already developed for similar jobs.

Salgado also teaches *an output device, which outputs the service list, made by the controller* (Col. 14, lines 35-49; Figs. 12-13 services listed on desktop).

**In regard to independent Claim 11,** Claim 11 reflects the linking and search devices as claimed in Claims 9 and 10 and is rejected along the same rationale.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
02/16/2006

William F. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
2/20/2006